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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,589

03/02/2004

Glenn Klecker

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EXAMINER

PRONE, JASON D

ART UNIT

PAPER NUMBER

3724

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/791,589	Applicant(s) KLECKER ET AL.	
	Examiner Jason Prone	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-8, 10, 11, 15-19, 22, 28-31 and 33 is/are pending in the application.
- 4a) Of the above claim(s) 28-31 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8, 10, 11, 15-19, and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The indicated allowability of claims 2-8, 10, 11, 15-19, and 22 is withdrawn in view of the newly discovered reference(s) to Hung et al. (2004/0010924). Rejections based on the newly cited reference(s) follow.

#### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

In this case, the duty to disclose incorporates the incorrect statement "I acknowledge the duty to disclose information which is material to the examination of this application in accordance with 37, C.F.R 1.56". The correct duty to disclose statement is as follows:

"I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56."

#### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "125", on page 10 line 12 and "196", on page 13 line 30, have both been used to designate side walls. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the

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figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: On page 10 line 12, item "125". On page 14 line 30, item "250". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: In Figure 1, items 210, 220, 236. In Figures 2, 3, 6, and 15, item 210. In Figure 4, item 37. In Figure 9, items 210 and 220. In Figure 11, item 154. In Figure 21,

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item 158. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to because Figure 22 is clearly labeled as handle 32 and incorporates the reference label "199". Page 13 lines 5-6 clearly disclose that item 199 belongs with handle 34. Making the use of 199 in Figure 22 incorrect. It is also noticed that item 199 is not present in any other Figure and deleting it would create another problem. The examiner recommends that the "199" be replaced with "198(199)" and the specification be amended to explain that 199 is not present in Figure 22 but incorporates the same structure as 198 but in handle 34. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the

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appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "blade safety lock that engages the blade assembly and is urged by the first handle", of claim 11, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. See 112 rejection below for more details.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

8. The disclosure is objected to because of the following informalities: On page 5 line 12, the phrase "holds he blade" should be replaced with "holds the blade".

Appropriate correction is required.

### ***Claim Objections***

9. Claims 11, 17, and 18 are objected to because of the following informalities: On line 4 of claim 11, the phrase "thereby\_holds" should be replaced with "thereby holds".

On line 2 of paragraph (c) of claim 17, the phrase "blade-being" should be replaced with "blade being".

In claim 18 line 4, the phrase "tang\_to" should be replaced with "tang to".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. In claim 11, the phrase "said blade safety lock engages one of said jaw and blade assembly" is unclear. The blade safety lock supported by the specification and Figures only engages the jaw. So it is unclear what structure allows the safety lock to engage the blade assembly. Also, the phrase "said blade safety lock being arranged with respect to one of said handles so that said one of said handles urges said blade lock into said engaged position when said one of said handles approaches said folded position" is unclear. The blade safety lock supported by the specification and Figures is only arranged with respect to the handle that attaches to the blade assembly (in this case, second handle). It is unclear what structure would allow the first handle to perform an urging function to the blade lock.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Hung et al. (2004/0010924)

**Claims 15, 16, and 19:**

In regards to claim 15, Hung et al. disclose the same invention including a jaw having a base (13), a blade defining a blade plane and including a blade base having a



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tang (23), a blade pivot joint interconnecting the jaw with the blade (14), the blade being movable about the pivot joint with respect to the jaw between an open and closed position (Figs. 2 and 6), a first handle (20 and 50) including an abutment face (in Fig. 2, the portion nearest 132 on 10 but the equivalent on 20), a second handle attached to the base of the jaw (10 and 40), a first handle pivot joint interconnecting the first handle with the tang (22), the first handle being movable about the handle pivot joint between an extended position and a folded position (Figs. 2 and 7), a leg extending laterally from the tang in a plane normal to the blade plane and engaged against the abutment face when the first handle is in the extended position (in Fig. 2, the extending portion just to the right of 251).

In regards to claim 16, Hung et al. disclose the first handle includes a channel having a channel base and a pair of side walls (Fig. 3) and the abutment face is a part of the channel base and the leg extends along and in contact with the abutment face when the first handle is in the extended position (Fig. 2).

In regards to claim 19, Hung et al. disclose the first handle includes a channel having a pair of side walls and a channel base defining the abutment face (Fig. 3), the tang includes a main portion (in Fig. 2, in-between 241 and 22) and the leg extends laterally at an angle away from the main portion and is aligned with the abutment face and rests against the abutment face when the first handle is in the extended position (Fig. 2).

Claims 17 and 18:

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In regards to claim 17, Hung et al. disclose the same invention including for paragraphs (a)-(f) see rejections to claims 15, 16, and 19 above. In regards to 17(g), Hung et al. disclose a leg extending from the tang and being oriented parallel with one of the side walls (in Fig. 2, the extending portion just to the right of 251) and the leg extends laterally from the tang and being parallel with the channel base and extending along and being engaged against and in contact with the abutment face when the first handle is extended (Fig. 2).

In regards to claim 18, Hung et al. disclose the tang and the leg are included in a single piece of metal and the leg is a portion of the single piece located in a plane oriented at an appropriate angle to a plane including the tang to align with the abutment face (Fig. 2).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung et al. in view of Thompson et al. (5,483,747). In regards to claims 2 and 3, Hung et al. disclose the invention including paragraphs (a) and (c)-(e) (see rejection to claims 15-19 above).

In regards to claim 4, Hung et al. disclose the jaw is a bypass support jaw and the cutter is a bypass cutting blade arranged to cooperate with the jaw (13 and 23) and is capable of pruning (Fig. 2).

However, with regards to claims 2(b) and 8, Hung et al. fail to disclose the blade assembly includes a blade carrier having a tang and a sharpened cutter mounted removably mounted on the blade carrier, the blade pivot joint includes a tension screw and locknut adjustable engaged therewith, and the screw and locknut being arranged to keep the blade assembly and the jaw closely alongside each other.

Thompson et al. teach it is old and well known in the art of shears to incorporate a blade assembly that includes a blade carrier (40a) having a tang (60) and a sharpened cutter mounted removably mounted on the blade carrier (47), the blade pivot joint includes a tension screw (50) and locknut adjustable engaged therewith (57), and the screw and locknut being arranged to keep the blade assembly and the jaw closely alongside each other (Fig. 3). Therefore, one of ordinary skill in the art, at the time of the invention, to have provided Hung et al. with the blade assembly, as taught by Thompson et al., because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

16. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung et al. in view of Thompson et al. as applied to claim 2 above, and further in view of Gringer et al. (2004/0045167). Hung et al. in view of Thompson et al. disclose the

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invention including each of the handles defines a respective channel having a pair of channel side walls (Fig. 3 in Hung et al.), the channels facing inwardly toward each other when in their folded position (Fig. 7 in Hung et al.) and facing outwardly apart from each other when in the extended positions with respect to the jaw and blade (Fig. 6 in Hung et al.), and one of the channel side walls includes a supporting portion of metal and a molded shell layer of a rigid thermoplastic material (paragraph [0026] in Hung et al.).

However, Hung et al. in view of Thompson et al. fail to disclose the side walls include cushioning portion of an elastomeric material overlying and extending along covering a margin and the cushioning portions are molded onto the shell layer/side walls.

Gringer et al. teach it is old and well known in the art of tool handles to incorporate side walls that include cushioning portions of an elastomeric material overlying and extending along covering a margin and the cushioning portions are molded onto the shell layer/side walls (abstract). Therefore, one of ordinary skill in the art, at the time of the invention, to have provided Hung et al. in view of Thompson et al. with cushioning portions, as taught by Gringer et al., because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hung et al. in view of Thompson et al. Hung et al. in view of Thompson et al. disclose the

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invention including a blade safety lock movable between an engaged position and a disengaged position (24 in Hung et al.), the lock being arranged with respect to one of the handles so that the handle urges the blade lock into the engaged position when the handle approaches the folded position (Fig. 7 in Hung et al.).

However, However, Hung et al. in view of Thompson et al. fail to disclose the safety lock is carried on one of the handle pivot joints.

The examiner takes Official notice that one of ordinary skill in the art, that it would have been obvious to construct that apparatus so as to put the safety lock on the same pivot as the handle. Therefore, one of ordinary skill in the art, at the time of the invention, to have provided Hung et al. in view of Thompson et al. with the safety lock sharing a pivot with the handle to reduce the amount of parts used for construction.

17. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hung et al. in view of Thompson et al. and Mizutani et al. (2002/0124415). In regards to paragraphs (a) and (c)-(e), Hung et al. disclose the invention (see rejection to claims 2-4 and 8 above).

In regards to paragraph (b), the combination of Hung et al. in view of Thompson et al. discloses the invention (see rejection to claims 2-4 and 8 above). Therefore, one of ordinary skill in the art, at the time of the invention, to have provided Hung et al. with the blade assembly, as taught by Thompson et al., because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

In regards to (e), Hung et al. disclose the invention including a spring urging the jaw and the blade assembly to pivot apart from each other (30).

However, Hung et al. fail to disclose the jaw defining a cavity surrounding the blade pivot joint and a groove extending away from the cavity, the spring located in the cavity, the spring having a pair of ends, a first end extending into the groove and being engaged with the jaw, and the other end extending to towards the second handle pivot joint and being engaged with the tang of the blade carrier.

Mizutani et al. teach that it is old and well known in the art of shears to incorporate a cavity surrounding the blade pivot joint (5) and a groove extending away from the cavity (11), a spring located in the cavity (15), the spring having a pair of ends (16), a first end extending into the groove and being engaged with the jaw (11), and the other end extending to towards the second handle pivot joint and being engaged with the tang of the blade carrier (the end labeled as 16). Therefore, one of ordinary skill in the art, at the time of the invention, to have provided Hung et al. with a spring cavity, as taught by Mizutani et al., because the substitution of one known element for another would have yielded predictable results.

18. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hung et al. in view of Mizutani et al. With regards to paragraphs (a)-(e), Hung et al. discloses the invention (see rejection to claims 15-19 above). With regards (f), the combination of Hung et al. in view of Mizutani et al. discloses the invention (see rejection to claim 10 above).

### ***Conclusion***

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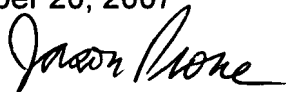
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jenkins, Jr. et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 8:00-5:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 20, 2007



Patent Examiner  
Jason Prone  
Art Unit 3724  
T.C. 3700